



En 2683
Patent Application
Atty. Ref.: 11696.0056

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Applicant: USHER et al.

Group Art Unit: 2683

Serial No.: 09/833,594

Examiner: B. J. Miller

Filed: April 13, 2001

For: MOBILE CELLULAR RADIO

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Commissioner of Patents
U.S. Patent and Trademark Office
Customer Window
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

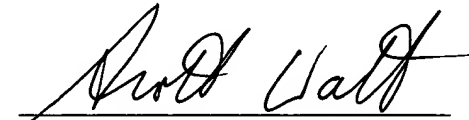
Dear Sir:

This document is in response to the Notice of Non-Compliant Amendment mailed August 2, 2005. The sole basis for the alleged non-compliance is that certain claims use the status identifier "previously added," which allegedly is not a "proper" status identifier under 37 CFR 1.121(c).

The Legal Instruments Examiner is respectfully directed to the June 1, 2005 notice from the Deputy Commissioner for Patent Examination Policy, which states: "Effective immediately, the Office will waive certain provisions of 37 CFR 1.121(c) so that the Office may accept amendments that include . . . certain variation of status identifiers. . . ." **The notice goes on to expressly state that the status identifier "previously added" is an acceptable alternative to "previously presented," and an acceptable amendment submission.** A courtesy copy of the June 1 memorandum to that effect is enclosed.

Accordingly, Applicants' use of "previously added" in Applicants' Amendment of July 22, 2005, complies with 37 CFR 1.121(c) as modified by the June 1, 2005 notice, and the finding of non-compliance is in error. Withdrawal of the finding and passage of the Amendment to the Examiner for consideration is appropriate and requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott D. Watkins", written over a horizontal line.

Scott D. Watkins
Reg. No. 36,715

August 29, 2005
Steptoe & Johnson LLP
1330 Connecticut Ave., N.W.
Washington, DC 20036
(202) 429-3000



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov



Date: June 1, 2005

To: Technology Center Directors
Patent Examining Corps

From: 
Joseph J. Rolla
Deputy Commissioner for Patent Examination Policy

Subject: Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)

Effective immediately, the Office will waive certain provisions of 37 CFR 1.121(c)¹ so that the Office may accept amendments that include: (1) the text of canceled claims or not entered claims, and (2) certain variations of status identifiers. Although revised 37 CFR 1.121² has been in effect for over 18 months, the Office is still receiving an unexpectedly high number of non-compliant amendments. The cycle for correcting non-compliant amendments causes extra work for applicants, examiners and the Office's Technical Support Staff, delays in prosecution and increased pendency of applications. Upon review, the Office has determined that certain requirements of 37 CFR 1.121 are not deemed essential in the Image File Wrapper (IFW) environment and that waiver of certain provisions of 37 CFR 1.121(c) will still allow examiners to clearly understand exactly what amendments have been made in IFW applications.

The following amendment submissions are now acceptable:

- 1) Claim listings that include the text of a canceled claim or a not entered claim if the amendment otherwise complies with 37 CFR 1.121, including use of the proper status identifier "canceled" or "not entered," respectively.
- 2) Claim listings that include status identifiers as set forth in the following table if the amendment otherwise complies with 37 CFR 1.121.

Table of status identifiers set forth in 37 CFR 1.121(c) and acceptable alternatives

Status Identifiers Set Forth in 37 CFR 1.121(c)	Acceptable Alternatives
1. Original	Original Claim; and Originally Filed Claim
2. Currently amended	Presently amended; and Currently amended claim
3. Canceled	Canceled without prejudice; Cancel; Cancelled; Canceled herein; Previously cancelled; Canceled claim; and Deleted
4. Withdrawn	Withdrawn from consideration; Withdrawn – new; Withdrawn claim; and Withdrawn-currently amended ³
5. Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim
6. New	Newly added; and New claim
7. Not entered	Not entered claim

The Office may also accept other variations of the status identifiers provided in 37 CFR 1.121(c) when the examiner determines that the status of the claims is accurate and clear. The Technical Support Staff (TSS) and examiners should liberally accept variations where the intent of the status identifiers is accurate and clear in view of the record of the application. If the TSS reviews an amendment (other than an after-final amendment) that includes status identifiers not listed in the above table and the amendment otherwise complies with 37 CFR 1.121, the TSS should only mail out a Notice of Non-Compliant Amendment where the status of the amended claim is not accurate and clear in view of the application file record. If the TSS enters an amendment and the examiner thereafter determines that the status of the claims is not accurate and clear in view of the application file record, a Notice of Non-Compliant Amendment must be mailed to the applicant. The examiner may request the TSS to mail out the Notice. Amendments filed after final rejection should continue to be forwarded to the examiner for the usual review of the amendment, including compliance with 37 CFR 1.121. When accepting alternative status identifiers, the examiner is not required to correct the status identifiers using an examiner's amendment, nor shall applicant be notified, and required, to submit a corrective compliant amendment.¹ The examiner does not need to make a statement on the record that the alternative status identifiers have been accepted.

Inquiries concerning this memorandum may be directed to Elizabeth Dougherty or Eugenia Jones, Senior Legal Advisors in the Office of Patent Legal Administration, at (571) 272-7703 or PatentPractice@uspto.gov.

¹ The Office shall waive the provision of 37 CFR 1.121(c)(4)(i) that no claim text shall be presented for any claim with the status of "canceled" or "not entered" and the provisions of 37 CFR 1.121(c) which requires usage of one of the following identifiers: Original, Currently amended, Canceled, Withdrawn, Withdrawn-currently amended, Previously presented, New, and Not entered.

² The Office revised the amendment practice set forth in 37 CFR 1.121 in a final rule that became effective July 30, 2003. See *Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 Fed. Reg. 38611 (June 30, 2003), 1272 Off. Gaz. Pat. Office 197 (July 29, 2003).

³ 37 CFR 1.121(c) sets forth that "Withdrawn-currently amended" is an acceptable variation of the status identifier "Withdrawn" for a withdrawn claim that is currently amended.